

REMARKS

The response contained herein does not attempt to add new matter into the present application for invention. Therefore, it is respectfully requested that this response be entered and that the claims to the present invention, kindly, be reconsidered.

The Office Action dated March 9, 2006 states that the response filed by the Applicants on December 12, 2005 was not completely responsive to the Office Action dated August 12, 2005. Accordingly, the Applicants, hereby, re-file their response to the Office Action dated August 12, 2005 that completely addresses all issues raised in the Office Action dated August 12, 2005.

Claims 1-33 are pending in the present application for invention. Claims 1-9, 18 and 20-24 are rejected. Claims 10-17, 19, 21, 25-33 are withdrawn from consideration.

Claims 1-9, 18 and 20-24 are rejected under the provision of 35 U.S.C §101 because the claimed invention is not within the technological arts. The Examiner has attempted to assert a term that has recently been used by the Examiner Corp referred to as "technological arts" as a test to determine patentability.

The Board of Patent Appeals and Interferences in the Precedential Opinion Ex parte CARL A. LUNDGREN, Appeal No. 2003-2088, Application 08/093,516, HEARD: April 20, 2004 unequivocally stated that there is no viable test for "technological arts".

The Board of Patent Appeals and Interferences stated within the opinion of Ex parte CARL A. LUNDGREN at the bottom of page 6 to the top of page 7:

"The examiner finds the separate 'technological arts' test in *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970); *In re Toma*, 575 F.2d 872, 197 USPQ 852 (CCPA 1978); and *Ex parte Bowman*, 61 USPQ2d 1669 (Bd. Pat. App. & Int. 2001) (non-precedential). We have reviewed these three cases and do not find that they support the examiner's separate 'technological arts' test."

Page 8 of opinion of the Board of Patent Appeals and Interferences in Ex parte CARL A. LUNDGREN discusses the Supreme Courts opinion.

"Finally, we note that the Supreme Court was aware of a 'technological arts test,' and did not adopt it when it reversed the Court of Customs and Patent Appeals in *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ 673 (1972). As explained in *Diamond v. Diehr*, 450 U.S. 175, 201, 209 USPQ 1, 14 (1981)."

Finally on the top of page 9 of opinion of the Board of Patent Appeals and Interferences in Ex parte CARL A. LUNDGREN:

"Our determination is that there is currently no judicially recognized separate "technological arts" test to determine patent eligible subject matter under § 101. We decline to propose to create one. Therefore, it is apparent that the examiner's rejection can not be sustained."

As demonstrated by the above discussion related to the Precedential Opinion of the Board of Patent Appeals and Interferences in Ex parte CARL A. LUNDGREN, this rejection is based on a flawed assumption that there exist a requirement based on "technological arts". Accordingly, this rejection is traversed.

The Applicants, respectfully, point out that the rejected claims produce a change that creates a useful and tangible result. For example, in Claim 1 there is a selection history that is partitioned into clusters. A selection by the user of one of the clusters is followed by an updating of the user profile. Therefore, a new user profile is created that did not previously exist. Accordingly, the rejected claims are statutory under the conventional rules to determine if a claim is statutory.

Claims 1-4, 6, 7-9, 18 and 20 are rejected under the provision of 35 U.S.C §102(e) as being anticipated by U.S. Patent No. 6,266,649 issued in the name of Linden et al. (hereinafter Linden et al.). In making the rejection, the Examiner mistakenly states that step 180 in Fig. 5 of Linden et al. is identifying item that have been selected by other users. Step 180 in Fig. 5 of Linden et al. relates to identifying items that have been selected by the user and not other users. This is clearly verified from a cursory look at col. 14, lines 36-41 of Linden et al. Col. 14, lines 36-41 of Linden et al. clearly states that in "step 180, the process 52 identifies all popular items that have been purchased by the user (from a particular shopping cart, if designated) or rated by the user, within the last six months." There is no other user, or third party user, that is being referred to by Linden et al. The partitioning that the Examiner refers to on col. 14, lines 36-41 of Linden et al. is not in the least based on a third party selection. Linden et al. at col. 14, lines 24-26 unequivocally states that the "Instant Recommendations service generates the recommendations based exclusively on the purchase history and any item ratings of the particular user." There is no disclosure or suggestion anywhere within Linden et al. for

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obtaining a third party selection history indicating items that are selected by at least one third party; or partitioning said third party selection history into clusters of items. Therefore, this rejection is traversed.

Claims 5 and 22-24 are rejected under the provision of 35 U.S.C §103(a) as being obvious over Linden et al. in view of Official Notice.

Regarding Claim 5, initially, the Applicants point out that there is no partitioning of third party selection history into clusters of items by Linden et al. Furthermore, is not well known to partition third party selection history into clusters of items employing a k-means clustering routine. The Applicants respectfully request that the Examiner produce prior art references that show that it is well known to partition third party selection history into clusters of items employing a k-means clustering routine.

Regarding Claim 22-24, the Examiner alleges that it is well known to weigh items from the user's own selection history more heavily than items from the third party selection history. The Applicants respectfully assert that it is not well known to weigh items from the user's own selection history more heavily than items from the third party selection history. The Applicants respectfully request that the Examiner produce prior art references that show that it is weigh items from the user's own selection history more heavily than items from the third party selection history.

Applicant is not aware of any additional patents, publications, or other information not previously submitted to the Patent and Trademark Office which would be required under 37 C.F.R. 1.99.

In view of the foregoing amendment and remarks, the Applicant believes that the present application is in condition for allowance, with such allowance being, respectfully, requested.

The Commissioner is hereby authorized to charge any fees associated with filing of this response to Account No. 50-3745, including any extension fees but excluding issue fees, and to credit any overpayment to the same account.

Respectfully submitted,

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